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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184978
Party	Plaintiff McNEIL-PPC, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

McNEIL-PPC, INC.,

Opposer,

-against-

WALGREEN CO.,

Applicant.

Opposition No. 91184978

**OPPOSER’S OPPOSITION TO
APPLICANT’S MOTION TO COMPEL PRODUCTION OF DOCUMENTS**

Opposer, McNEIL-PPC, Inc. (“McNEIL”), submits this memorandum in opposition to Applicant’s Motion to Compel Production of Documents (“Motion to Compel”).

Applicant seeks to force McNEIL to produce the documents identified on McNEIL’s privilege log – namely, correspondence between lawyers concerning WAL-ZYR, the mark that is the subject of this opposition. Applicant’s motion rests on the premise that the correspondence cannot be protected from discovery because it is between lawyers for McNEIL’s parent company, Johnson & Johnson (“J&J”), and UCB, the owner of the ZYRTEC mark. This premise is wrong as a matter of both fact and law. Applicant is well aware of the relationship between McNEIL and UCB, having distributed McNEIL’s ZYRTEC products in its stores for nearly two years now. Moreover, communications do not lose work product status or attorney-client privilege merely by being shared among parties with a common legal interest, such as McNEIL, J&J and UCB.

Applicant's motion is a waste of the Board's and McNEIL's time and resources. For the reasons set forth below, McNEIL respectfully requests that the Board deny Applicant's Motion to Compel in its entirety.

BACKGROUND

A. The Relationship Between McNEIL, J&J and UCB

In this opposition, McNEIL alleges that Applicant's mark WAL-ZYR is likely to be confused with and is dilutive of the mark ZYRTEC. UCB Pharma S.A. is the owner of the ZYRTEC trademark. McNEIL, through its parent company, J&J, is the exclusive United States licensee of the mark ZYRTEC. (Declaration of David Emch in Support of Opposer's Opposition to Applicant's Motion to Compel Production of Documents, dated November 2, 2009 ("Emch Decl."), ¶ 3; Declaration of Jake D. Feldman in Support of Opposer's Opposition to Applicant's Motion to Compel Production of Documents, dated November 2, 2009 ("Feldman Decl."), ¶ 6.) Despite its feigned ignorance, Applicant knows this to be a fact, since it has been distributing McNEIL's ZYRTEC products in its stores for nearly two years now and worked with McNEIL for months before those products made their way to Applicant's stores.

When McNEIL became aware of Applicant's infringing WAL-ZYR mark, McNEIL, not surprisingly, communicated with the trademark owner UCB Pharma S.A. and its U.S. subsidiary UCB, Inc. (together, "UCB") regarding the legal implications of and legal strategy related to Applicant's use and registration of the WAL-ZYR mark. Communications with UCB were undertaken on McNEIL's behalf by legal counsel employed by McNEIL's parent company, J&J. J&J provides legal services to McNEIL, which does not have its own in-house counsel. (Feldman Decl., ¶¶ 4-5.) Thus, J&J's legal department functions as counsel to

McNEIL, and it was in that position that J&J communicated with UCB regarding the WAL-ZYR mark.

The communications between McNEIL/J&J and UCB were undertaken to protect those entities' common legal interest in the ZYRTEC mark. (Emch Decl. at ¶¶ 5-7; Feldman Decl. at ¶¶ 8-10). The communications were undertaken on the express understanding that they would be confidential as to third parties – most notably, Applicant – and would be shielded from discovery. (Emch Decl. at ¶ 7; Feldman Decl. at ¶ 10.)

B. Applicant's Document Request and McNEIL's Objections

On May 5, 2009, Applicant served on McNEIL Applicant's Second Request for Production of Documents and Things, which included a request targeted to the communications between UCB and McNEIL or its parent company, J&J. Specifically, Request No. 32 seeks

[a]ll communications between persons employed by UCB Pharma, S.A., UCB S.A. and McNeil-PPC, Inc. [sic], McNEIL Consumer Healthcare,¹ Johnson & Johnson, or any of their divisions or related companies in Opposer's possession, custody and control concerning Applicant's use or registration of Applicant's Mark or this Opposition.

McNEIL objected to Request No. 32 on the following bases (among other general objections):

- privilege (“[the request] calls for documents subject to the attorney-client, work product or other privilege”);
- burdensomeness (“The Request exposes Opposer to undue burden or expense in relation to its likely benefit, taking into account the needs of the case, the property in controversy, Opposer's resources, the importance of the issues at stake in the litigation, and the importance of the proposed discovery in resolving the issues”);
- duplicativeness (“The Request is unreasonably cumulative or duplicative, or the requested information can be obtained from some other source that is more convenient, less burdensome, or less expensive”);
- irrelevance (“The Request is not reasonably calculated to lead to the discovery of admissible or relevant evidence”);

¹ McNeil Consumer Healthcare is a division of McNEIL

- overbreadth (“The Request is not reasonably particular, or seeks information merely tangential to the matters at issue in the case, or is not limited to a particular time period or geographic region”); and
- ambiguousness (“The wording of the Request is vague and/or ambiguous including, without limitation, due to use of undefined terms”).

(See Declaration of Laura Popp-Rosenberg in Support of Opposer’s Opposition to Applicant’s Motion to Compel Production of Documents dated November 2, 2009 (“Popp-Rosenberg Decl.”), ¶ 4 and Exh. 1; Mot. to Compel, Exh. B.) Based on these multiple objections, McNEIL did not produce any responsive documents.

Applicant first notified McNEIL of its concerns with McNEIL’s refusal to produce documents in response to Request No. 32 by letter dated June 22, 2009. (Popp-Rosenberg Decl., ¶ 6 and Exh. 2.) Thereafter, the parties exchanged multiple emails and held at least one teleconference with respect to McNEIL’s objections to the request. (*Id.* at ¶¶ 7, 9 and Exhs. 3, 5.) The correspondence between counsel focused on McNEIL’s objections to producing privileged documents, and McNEIL’s counsel specifically informed Applicant’s counsel that the correspondence between McNEIL, J&J and UCB was protected by the attorney-client privilege and the work product doctrine. (*Id.* at ¶ 10 and Exhs. 3, 5.)

Ultimately, despite its numerous objections, McNEIL agreed to produce a privilege log listing documents responsive to Request No. 32.² (*Id.* at ¶ 8 and Exh. 3.) In agreeing to produce the privilege log, McNEIL expressly reserved all of its other objections to the request. (*Id.* at ¶ 8 and Exhs. 3-4.)

C. McNEIL’s Privilege Log

McNEIL’s privilege log (the “Privilege Log”) identifies correspondence exchanged between representatives of UCB and McNEIL to discuss the WAL-ZYR dispute. As identified

on the Privilege Log, all of the correspondence was between attorneys or other legal staff of UCB and J&J (acting as McNEIL's counsel), or their respective outside counsel. Specifically, the persons involved in one or more communications were:

On behalf of McNEIL:

- John Crisan, General Counsel, J&J;
- Jerry Swindell, Senior Counsel, J&J;
- Jake Feldman, Senior Trademark Attorney, J&J;
- Maria Kirczow, Trademark Paralegal, J&J;
- Hal Russo, Vice-President, Business Development, J&J; and
- James Weinberger, Partner, Fross Zelnick Lerhman & Zissu, P.C. litigation counsel for McNeill.

On behalf of UCB:

- Robert Trainor, Executive Vice-President & General Counsel, UCB;
- Allen Norris, Vice-President, Head Group IP, UCB;
- Benoit Beuken, Chief Trademark Counsel, UCB;
- Jacques Somerlinckx, Senior Trademark Counsel, UCB;
- David Emch, Associate General Counsel, UCB, Inc.;
- A. John P. Mancini, Partner, Mayer Brown LLP, outside counsel for UC; and
- Gregory Frantz, Associate, Mayer Brown LLP.

McNEIL claimed the attorney-client privilege and/or the work product doctrine covered each of the documents identified on its Privilege Log.

² Other than the documents identified on the privilege log, there is no correspondence between McNEIL or J&J and UCB concerning Applicant's use or registration of Applicant's Mark or this opposition. (Feldman Decl. at ¶ 12.)

ARGUMENT

I. Correspondence Between UCB and McNEIL/J&J Is Protected and Irrelevant

A. *Correspondence Between UCB and MCNEIL/J&J Is Shielded by the Work Product Doctrine*

The work product doctrine protects documents prepared in anticipation of litigation, by or for a party or the party's agent. Fed. R. Civ. P. 26(b)(3). The doctrine covers the work product of in-house attorneys, outside attorneys and their agents. *Upjohn Co. v. U.S.*, 449 U.S. 383 (1981). The protection afforded by the work product doctrine is qualified, so that work product may be subject to discovery if the requesting party can show a substantial need for the document and undue hardship in obtaining its substantial equivalent by other means. Fed. R. Civ. P. 26(b)(3)(A)(ii). However, opinion work product – that is, work product containing an attorney's mental impressions, conclusions, opinions or legal theories – enjoys almost absolute protection from discovery. *See id.* at 26(b)(3)(B); *Upjohn Co.*, 449 U.S. at 401; *Dir., Office of Thrift Supervision v. Vinson & Elkins, LLP*, 124 F.3d 1304 (D.C. Cir. 1997) (“Opinion work product . . . is virtually undiscoverable.”) (citations omitted); *In re Murphy*, 560 F.2d 326, 336 (8th Cir. 1977) (“opinion work product enjoys a nearly absolute immunity and can be discovered only in very rare and extraordinary circumstances”); *Duplan Corp. v. Moulinage*, 509 F.2d 730, 734 (4th Cir. 1974) (“In our view, no showing of relevance, substantial need or undue hardship should justify compelled disclosure of an attorney's mental impressions, conclusions, opinions or legal theories.”).

There can be no question that the correspondence at issue is protected by the work product doctrine. The correspondence took place in anticipation of legal action against the WAL-ZYR mark. (Emch Decl. at ¶ 5-6; Feldman Decl. at ¶ 8-9.) The correspondence took place almost exclusively among legal counsel, and as such necessarily consisted of the writing

attorney's mental impressions and legal opinions. *See Stix Prods., Inc. v. United Merchants & Mfrs. Inc.*, 47 F.R.D. 334, 337 (S.D.N.Y. 1969) (finding document constituted work product because it is "a writing prepared by an attorney, couched in legal terminology, embodying a compendium of the attorney's mental impressions and beliefs, and reflects the attorney's opinion which is based on legal analysis and reasoning and involved in the exercise of legal skills") (citation omitted).

Nor was there any waiver of work product protection merely because the correspondence took place among multiple entities. As detailed above, McNEIL, J&J and UCB share a common legal interest in the ZYRTEC mark. It is "well-settled" that the communication of work product between entities sharing a common legal interest, such as UCB, J&J and McNEIL, does not operate as a waiver of work product protection. *Weil Ceramics & Glass, Inc. v. Work*, 110 F.R.D. 500, 502 (E.D.N.Y. 1986) (citing *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1172 (D.S.C. 1975) ("The sharing of information between counsel for parties having common interests does not destroy the work product privilege.")); *see Burlington Indus. v. Exxon Corp.*, 65 F.R.D. 26, 45 (D. Md. 1974) (exchange of information between joint licensees of patent does not waive work product immunity); *Stix Prods., Inc.*, 47 F.R.D. at 338 (no waiver when third party shared attorney's legal opinion on patent validity with plaintiff's attorney, where both parties had interest in negating patent); *Stanley Works v. Haeger Potteries, Inc.*, 35 F.R.D. 551, 555 (N.D. Ill. 1964) ("Where attorneys for parties having a mutual interest in litigation exchange their work product, it remains protected by a qualified privilege."); *Transmirra Prods. Corp. v. Monsanto Chem. Co.*, 26 F.R.D. 572, 578, 128 U.S.P.Q. 84, 88 (S.D.N.Y. 1960) ("the exchange of 'work products' among attorneys for parties sharing a common interest does not thereby render such information vulnerable to pre-trial discovery procedures"); *Vilastor-Kent Theatre*

Corp. v. Brandt, 19 F.R.D. 522, 524 (S.D.N.Y. 1956) (no waiver where possible co-defendant shared work product with defendant).³

Applicant's argument that the work-product doctrine categorically cannot apply to correspondence between J&J and UCB because neither of these entities are party to this opposition (Motion to Compel at ¶ 4) is without merit. First, as discussed above, the correspondence by J&J was not undertaken as a stranger to this action, but rather as legal counsel to opposer McNEIL. Moreover, there is simply no rule that the work product doctrine protects only materials prepared by or for a party to the litigation in which the documents are sought. *Stix Prods., Inc.*, 47 F.R.D. at 337 (“[t]he work-product privilege is not . . . limited to documents prepared by a party in the course of actual litigation with the party seeking discovery of the document”).

That UCB brought no action itself is simply irrelevant to the question of whether the work-product doctrine applies. In fact, case law is legion with examples of the work product doctrine being applied despite materials being shared with a non-party to the litigation. *E.g.*, *Stanley Works*, 35 F.R.D. at 554-55 (correspondence between plaintiff and its partner in joint licensing program immune from production, even though partner was not party to the action); *cf.* *Stix Prods., Inc.*, 47 F.R.D. at 337 (work-product doctrine shielded patent opinion of third party even though no infringement lawsuit had been commenced against it); *Transmirra Prods. Corp.*, 26 F.R.D. at 578 (information shared between two alleged infringers of patent covered by privilege, even though one infringer was never sued); *Vilastor-Kent Theatre Corp.*, 19 F.R.D. at

³ The law's recognition that the sharing of work product among entities with joint interests does not work a waiver of work product protection is consistent with the general precept that the work product doctrine can be waived by voluntary disclosure to a third person *only* where such disclosures substantially increase the possibility that an adversary would thereby get access to the information. *Bank Brussels Lambert v. Chase Manhattan Bank, N.A.*, No. 93 Civ. 5298, 1996 WL 944011, at *3 (S.D.N.Y. Dec. 19, 1996). Here, there is no aspect of the communications between McNEIL/J&J and UCB that increases the possibility that Applicant would gain access, particularly since the parties agreed that such communications would be kept confidential.

525 (communication from possible co-defendant to defendant protected under work product doctrine).

In sum, the correspondence was undertaken by counsel to parties sharing a common interest in the ZYRTEC mark, and is an expression of the counsel's mental impressions and legal thinking regarding the WAL-ZYR mark. Such communications fall under the protection of the work product doctrine, and the Board should deny Applicant's attempt to force McNEIL to produce such correspondence.

B. Correspondence Between McNEIL/J&J and UCB Is Protected by the Attorney-Client Privilege

In addition to the work product doctrine, the correspondence is protected by the attorney-client privilege.

Applicant argues that the attorney-client privilege cannot apply here because any privilege that might have attached was waived when the correspondence was shared among McNEIL, J&J and UCB. (Mot. to Compel at ¶ 7.) However, there was no waiver given the existence of the "common interest exception," under which communication among parties with a joint legal interest in the subject of the communication does not operate as a waiver of the attorney-client privilege. Although applicant admits the existence of the common interest exception, Applicant contends that it does not apply to this case. (Mot. to Compel at ¶ 7.) The basis for Applicant's bald contention is a mystery. As discussed above, there can be no question that UCB, the owner of the ZYRTEC mark, and McNEIL, licensee of the ZYRTEC mark, share a common interest in the dispute concerning Applicant's WAL-ZYR mark. *Cf. In re Regents of the Univ. of Cal.*, 101 F.3d 1386, 1390 (Fed. Cir. 1996) (patent owner and exclusive licensee shared common legal interest in patent); *Gen-Probe Inc. v. Amoco Corp.*, No. 94 C 5069, 1996 WL 264707, at *3 (N.D. Ill. 1996) (parties to licensing agreement shared common legal interest);

Baxter Travenol Labs., Inc. v. Abbott Labs., No. 84 C 5103, 1987 WL 12919, at *2 (N.D. Ill. June 19, 1987) (party with option for exclusive license shared common legal interest in developing, prosecuting, and protecting patent with patent owner). UCB, J&J and McNEIL's common legal interest in the ZYRTEC mark entitle them to share confidential and privileged legal communications regarding the threat posed by Applicant's WAL-ZYR mark without waiver of the attorney-client privilege.

Applicant's second argument against application of the common interest exception is that the parties "did not agree that any privilege in the communications would be retained despite the disclosures." (Mot. to Compel at ¶ 8.) Applicant cites no factual basis for this assertion. Worse, Applicant made this assertion despite knowing that the parties share a common legal interest in the ZYRTEC mark and despite McNEIL's counsel's representations that McNEIL, J&J and UCB did in fact agree that the communications would be kept confidential. (Popp-Rosenberg Decl., ¶ 10.) In any event, Applicant cannot dispute the facts as set forth in the accompanying declarations of J&J and UCB. Nor can Applicant reasonably dispute the application of the common interest exception to those facts.

Applicant's remaining arguments as to why the attorney-client privilege does not apply are similarly devoid of any foundation in fact or law. For example, Applicant asserts that the common interest exception cannot apply because the communications were between counsel, "not between a client and his attorney." (Mot. to Compel at ¶ 6.) But in-house counsel for UCB and McNEIL wear multiple hats: as employees of their respective companies they are "clients," and as legal counsel to those companies they are "attorneys." Cf. *Burlington Indus.*, 65 F.R.D. at 36-37 (discussing different positions of in-house counsel within the attorney-client paradigm); 1

Paul R. Rice, *Attorney-Client Privilege in the United States* (“Rice on Privilege”), § 4:4 at 4-32-33 (same).

And, regardless of whether the attorneys were serving as “client” or “attorneys,” their correspondence is protected by their shared interest in the ZYRTEC mark. Rice on Privilege, § 4:33 (“Clients without a common attorney may communicate among themselves and the separate attorneys on matters of common legal interest, for the purpose of preparing a joint strategy, and the attorney-client privilege will protect those communications”); *In re Regents of the Univ. of Cal.*, 101 F.3d at 1390-91 (common interest exception shields communications between licensee’s counsel and patent owner’s counsel); *U.S. v. Stotts*, 870 F.2d 288, 290 (5th Cir. 1989) (confidential statements regarding common strategy are privileged “even though the statements are exchanged between attorneys”); *Go Medic. Indus. Pty., Ltd. v. C. R. Bard, Inc.*, No. 3:95 MC 522, 1998 WL 1632525, at *3 (D. Conn. Aug. 14, 1998), *judgment rev’d in part and vacated in part on other grounds*, 250 F.3d 763 (Fed. Cir. 2000) (“Under the common interest rule, *parties and counsel* involved in a joint defense or enterprise may disclose privileged information to each other without destroying the privileged nature of those communications.”) (emphasis added); *In re Grand Jury Subpoenas*, 902 F. 2d 244, 249 (4th Cir. 1990) (“persons who share a common interest in litigation should be able to communicate with their respective attorneys *and with each other* to more effectively prosecute or defend their claims”) (emphasis added); *see also* 1 Rice on Privilege, § 4:35 at 4-254-255, n.25-27 (collecting cases).⁴

⁴ *See also In re U.S. Healthcare, Inc. Sec. Litig.*, No. 88-0559, 1989 U.S. Dist. LEXIS 1043, at *3 (E.D. Pa. Feb. 7, 1989) (“Insofar as inter-attorney communications . . . contain information which would otherwise be privileged as communications to him from a client, that information should be entitled to the same degree of protection from disclosure”); *Burlington Indus.*, 65 F.R.D. at 37 (“The [attorney-client] privilege . . . extends to the attorney’s legal advice and opinions which encompass the thoughts and confidences of the client.”) (citations omitted).

Lastly, Applicant contends that the attorney-client privilege and by extension the common interest exception do not attach to the correspondence because neither UCB nor J&J is a party to this opposition. (Mot. to Compel at ¶ 6.) Again, Applicant's argument has no merit. First, J&J communicated with UCB as legal counsel to McNEIL, and in that role was not a stranger to this proceeding. Further, "[t]he common-interest principle does not require that both, or indeed either, of the communicants be parties to a litigation." *Johnson Elec. N. Am., Inc. v. Mabuchi N. Am. Corp.*, No. 88 Civ. 7377, 1996 WL 191590, at *5 (S.D.N.Y. Apr. 19, 1996).

In sum, Applicant seeks to force McNEIL to produce communications constituting or encompassing attorney-client confidences, shared among entities with a common legal interest in this proceeding. The Board should rule that the attorney-client privilege protects such correspondence and, accordingly, should deny Applicant's motion.

C. Correspondence Between McNEIL/J&J and UCB Is Irrelevant

Not only is the correspondence protected by both the work product doctrine and the attorney-client privilege, but also it bears no relevance to any issue in this proceeding.

Federal Rule of Evidence 401 defines "relevant evidence" as "evidence having any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence." McNEIL has requested Applicant on multiple occasions to explain how correspondence between UCB and McNEIL/J&J could be relevant to any issue in this proceeding. (Popp-Rosenberg Decl., Exh. 3.) Applicant's only response is that such correspondence may "have some relevance to the issue of standing"⁵ and may reveal information regarding UCB's "opinion on issues related to this

⁵ In its Motion to Compel, Applicant does not repeat its previous statement that the correspondence with UCB is relevant to the issue of McNEIL's standing. While it is therefore unclear whether Applicant continues to maintain this argument, McNEIL nonetheless addresses it herein for the sake of completeness.

matter.”⁶ (*Id.*) As to this latter category, Applicant has specified that the correspondence may reveal whether UCB believes that the WAL-ZYR mark is confusingly similar to or dilutive of the WAL-ZYR mark. (*Id.*; *see also* Mot. to Compel at ¶ 9.)

UCB’s belief or opinion is not relevant to any issue in this opposition proceeding. UCB’s opinion as to whether the WAL-ZYR mark is confusingly similar to or dilutive of the ZYRTEC mark has no bearing whatsoever on whether the WAL-ZYR mark *in fact* is confusingly similar to or dilutive of the ZYRTEC mark. If UCB believed that the WAL-ZYR mark was an infringement, would the Board rule in McNEIL’s favor? Of course not. Similarly, if UCB were to believe that WAL-ZYR is not an infringement, it would have no impact on the ultimate decision in this matter.

UCB’s belief or opinion as to McNEIL’s standing in this proceeding is likewise irrelevant, since what UCB may or may not believe about McNEIL’s standing does not impact whether or not McNEIL *in fact* has standing.

Because Applicant’s Request No. 32 seeks documents that are not relevant to any issue in this proceeding, and because such documents would not be admissible at trial, Fed. R. Evid. 402 (“Evidence which is not relevant is not admissible.”), the request is fatally objectionable as not reasonably calculated to lead to the discovery of admissible evidence. Therefore, the Board should rule that McNEIL is not be required to produce any documents in response to Request No. 32, and deny Applicant’s Motion to Compel also on this basis.

⁶ Even if either of these two topics were relevant to the proceeding, Request No. 32 is not limited to seeking correspondence only as to these two topics. For that reason, Request No. 32 is also impermissibly overbroad, as seeking information that is not reasonably particular to any topic that Applicant even argues is relevant.

II. Correspondence Between McNEIL and J&J

Applicant's Motion to Compel seems to suggest that Applicant is seeking production not only of all correspondence between McNEIL/J&J and UCB, but also all correspondence between McNEIL and J&J relating to Applicant's use or registration of the WAL-ZYR mark or this proceeding. McNEIL should not be required to produce such correspondence.

First, McNEIL disputes that Request No. 32 on its face even calls for the production of correspondence between McNEIL and J&J. In pertinent part, the request seeks communications between "UCB Pharma, S.A., UCB S.A. *and* McNeil-PPC, Inc. [sic], McNeil Consumer Healthcare, Johnson & Johnson." (Emphasis added.) The placement of the word "and" conveys that Applicant seeks communications between the parties separated by that word – that is, UCB on the one hand, and McNEIL and J&J on the other hand. Thus, a fair reading of the request does not bring within its scope communications between J&J and MCNEIL.

To the extent Applicant intended to bring within the scope of Request No. 32 correspondence between McNEIL and J&J, the request is fatally objectionable as burdensome, overbroad, duplicative and not reasonably calculated to lead to the discovery of relevant (and therefore admissible) evidence. Since the products sold under the WAL-ZYR mark are directly competitive with products sold under the ZYRTEC mark, it would be reasonable for McNEIL to communicate on an ongoing basis with its parent, J&J, concerning Applicant's use of WAL-ZYR. Any such regular communications on business issues would have no relevance to the dispute. Applicant has made no showing as to how they would be relevant, and to require McNEIL to locate, review and produce all such correspondence would be unnecessarily burdensome.⁷

⁷ Certain business communications between J&J and McNEIL concerning Applicant's use of the WAL-ZYR mark may be responsive to other, more specific documents requests served by Applicant. From this perspective, Request

Moreover, any relevant, responsive correspondence would be covered by the attorney-client privilege and the work product doctrine. J&J legal staff functions as counsel to McNEIL, which does not have its own legal department. Correspondence between McNEIL's counsel and McNEIL's business people about this dispute is covered by the attorney-client privilege and/or the work product doctrine. *See* 1 Edna Selan Epstein, *The Attorney-Client Privilege and the Work-Product Doctrine* at 205 (5th ed. 2007); 1 Rice on Privilege, § 4:24 (intercorporate communications between parent and subsidiary protected); *see also Duplan Corp.*, 397 F. Supp. at 1167; *cf. Weil Ceramics & Glass, Inc.*, 110 F.R.D. at 503 (communications among related companies covered by attorney-client privilege) (citation omitted).

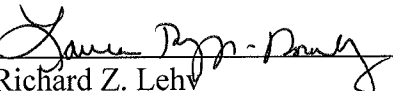
For these reasons, McNEIL therefore respectfully requests the Board to deny Applicant's motion to compel communications between McNEIL and J&J.

CONCLUSION

For all the reasons stated above, McNEIL respectfully requests that the Board deny Applicant's Motion to Compel in its entirety.

Dated: New York, New York
November 2, 2009

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

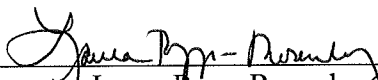
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No. 32 is duplicative. In any event, to the extent there is correspondence between McNEIL and J&J responsive to other, unobjectionable, document requests, McNEIL has produced it or will do so.

CERTIFICATE OF SERVICE

This is to certify that I caused a true and correct copy of the foregoing Opposer's Opposition to Applicant's Motion to Compel Production to be served via First Class Mail in an envelope addressed to counsel for Applicant, Mark J. Liss, Esq., Leydig, Voit & Mayer, Ltd, Two Prudential Plaza, Suite 4900, Chicago, Illinois 60601-6731, this 2nd day of November, 2009.



Laura Popp-Rosenberg

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

McNEIL-PPC, INC.,

Opposer,

-against-

WALGREEN CO.,

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Opposition No. 91184978

**DECLARATION OF DAVID EMCH
IN SUPPORT OF OPPOSER'S OPPOSITION TO
APPLICANT'S MOTION TO COMPEL PRODUCTION OF DOCUMENTS**

I, David Emch, hereby declare under penalty of perjury:

1. I am Associate General Counsel at UCB, Inc., a corporation duly organized under the laws of the State of Delaware, with its principal place of business at 1950 Lake Park Drive, Smyrna, Georgia. UCB, Inc. is a subsidiary of UCB S.A. I am authorized and do submit this declaration on behalf of UCB S.A. and all of its related companies and subsidiaries, including but not limited to UCB, Inc., (collectively, "UCB") in support of Opposer's Opposition to Applicant's Motion to Compel Production of Documents. I make this declaration based on personal knowledge of the facts and circumstances set forth herein.

2. UCB is the owner of the mark ZYRTEC in the United States and elsewhere.

3. In the United States, UCB licenses the ZYRTEC mark on an exclusive basis to McNEIL-PPC, Inc. ("McNEIL") for use in connection with over-the-counter medications.

4. In approximately March 2008, UCB became aware that Walgreen Co. ("Walgreens") was selling an over-the-counter allergy medicine competitive to ZYRTEC allergy medicine under the mark WAL-ZYR.

5. Because Walgreens's sale of the WAL-ZYR medicine impacted UCB's rights as the owner of the ZYRTEC mark and McNEIL's rights as licensee of the ZYRTEC mark, I as well as other attorneys and business persons at UCB, as well as Mayer Brown LLP (our outside counsel), communicated with attorneys and business persons at McNEIL and its parent company Johnson & Johnson, as well as with McNEIL's outside counsel, regarding duties and obligations arising out of a certain license agreement by and among UCB and a predecessor-in-interest of McNEIL/Johnson & Johnson relating to, among other things, the ZYRTEC mark

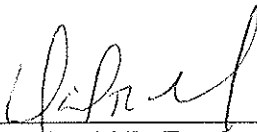
6. There were also communications by and among UCB, McNEIL and Johnson & Johnson concerning the legal implications of Walgreens's sale of the WAL-ZYR medicine.

7. UCB, McNEIL and Johnson & Johnson undertook the joint discussions described in Paragraphs 5 and 6 above with the understanding that the communications were and would be kept confidential as to third parties. UCB understood that its communications with McNEIL and Johnson & Johnson would be considered privileged under the common interest exception and therefore immune from discovery by Walgreens.

8. UCB is therefore opposed to Walgreens's motion seeking to compel McNEIL to produce the communications described in Paragraphs 5 and 6 above, which communications were undertaken on the understanding that they were privileged and confidential.

I declare under penalty of perjury that the foregoing is true and correct.

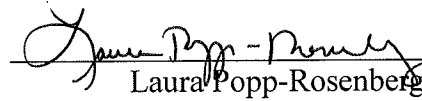
Executed this 2nd day of November, 2009.



David R. Emch

CERTIFICATE OF SERVICE

This is to certify that I caused a true and correct copy of the foregoing Declaration of David Emch in Support of Opposer's Opposition to Applicant's Motion to Compel Production of Documents to be served via First Class Mail in an envelope addressed to counsel for Applicant, Mark J. Liss, Esq., Leydig, Voit & Mayer, Ltd, Two Prudential Plaza, Suite 4900, Chicago, Illinois 60601-6731, this 2nd day of November, 2009.


Laura Popp-Rosenberg

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

McNEIL-PPC, INC.,

Opposer,

-against-

WALGREEN CO.,

Applicant.

Opposition No. 91184978

**DECLARATION OF JAKE D. FELDMAN
IN SUPPORT OF OPPOSER'S OPPOSITION TO
APPLICANT'S MOTION TO COMPEL PRODUCTION OF DOCUMENTS**

I, Jake D. Feldman, hereby declare under penalty of perjury:

1. I am Senior Trademark Attorney at Johnson & Johnson ("J&J"), a corporation duly organized under the laws of New Jersey, with its principal place of business at One Johnson & Johnson Plaza, New Brunswick, New Jersey. J&J is the parent company of opposer McNEIL-PPC, Inc. ("McNEIL"). I am authorized and do submit this declaration on behalf of J&J and McNEIL in support of Opposer's Opposition to Applicant's Motion to Compel Production of Documents. I make this declaration based on personal knowledge of the facts and circumstances set forth herein.

A. My Role as Counsel to McNEIL

2. J&J is one of the largest healthcare companies in the world, operating in 57 countries through more than 250 subsidiary companies.

3. J&J itself is a holding company that directly or indirectly wholly owns 100% of the stock of its subsidiaries such as McNEIL. In addition, J&J provides certain

centralized support and administrative functions for such subsidiaries, but does not engage in any manufacturing, distribution or sales of products.

4. Among the centralized functions J&J provides to its subsidiaries are legal services. Similar to any client that utilizes lawyers employed by a law firm, J&J subsidiaries, such as McNEIL, utilize lawyers, paralegals and other legal staff employed by J&J to provide legal advice and counseling. Such subsidiaries, including McNEIL, are charged by J&J for the use of its legal staff.

5. As a Senior Trademark Attorney at J&J, I am involved in trademark registration, protection and enforcement matters. Among the J&J subsidiaries to which I provide trademark advice and counseling is McNEIL. McNEIL does not have its own in-house trademark counsel, and I am one of the lawyers at J&J who fills that role for McNEIL. In other words, McNEIL is one of my clients.

B. The WAL-ZYR Dispute

6. J&J is the exclusive U.S. licensee of UCB S.A for the trademark ZYRTEC. J&J sublicenses the ZYRTEC mark on an exclusive basis to McNEIL.

7. In February 2008, J&J and McNEIL became aware that Walgreen Co. (“Walgreens”) was selling an over-the-counter allergy medicine competitive to ZYRTEC allergy medicine under the mark WAL-ZYR.

8. Because Walgreens’s sale of the WAL-ZYR medicine equally impacted UCB’s rights as the owner of the ZYRTEC mark and J&J and McNEIL’s rights as licensee of the ZYRTEC mark, I as well as other attorneys at J&J, and our outside counsel Fross Zelnick Lerhman & Zissu, P.C., communicated with attorneys and business

persons at or representing UCB S.A. and UCB, Inc. (together, "UCB") regarding the WAL-ZYR mark.

9. The purpose of the communications between J&J, McNEIL and UCB (and their respective outside counsel) concerning WAL-ZYR was to discuss the legal implications of the WAL-ZYR mark and to discuss legal strategy with respect to the same.

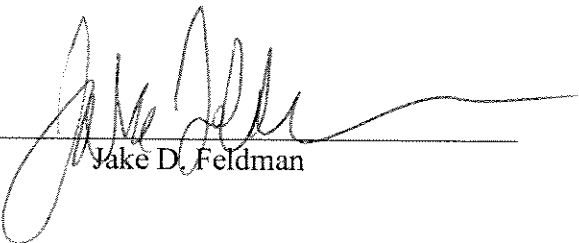
10. J&J, McNEIL and UCB undertook joint discussions concerning WAL-ZYR with the express understanding that the communications were and would be kept confidential as to third parties. The entities understood that the communications would be considered privileged and therefore immune from discovery by Walgreens.

11. J&J is opposed to Walgreens's motion seeking to compel McNEIL to produce communications between J&J, McNEIL and UCB concerning the WAL-ZYR mark and legal strategy with respect to the same, which communications were undertaken on the understanding that they were privileged and confidential.

12. Other than the documents identified on McNEIL's privilege log, McNEIL is unaware of any correspondence between McNEIL or J&J with UCB concerning Walgreens's WAL-ZYR mark of this opposition proceeding.

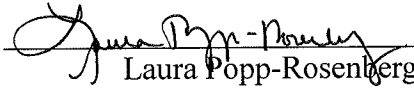
I declare under penalty of perjury that the foregoing is true and correct.

Executed this 2nd day of November, 2009.


Jake D. Feldman

CERTIFICATE OF SERVICE

This is to certify that I caused a true and correct copy of the foregoing Declaration of Jake D. Feldman in Support of Opposer's Opposition to Applicant's Motion to Compel Production of Documents to be served via First Class Mail in an envelope addressed to counsel for Applicant, Mark J. Liss, Esq., Leydig, Voit & Mayer, Ltd, Two Prudential Plaza, Suite 4900, Chicago, Illinois 60601-6731, this 2nd day of November, 2009.



Laura Popp-Rosenberg

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

McNEIL-PPC, INC.,

Opposer,

-against-

WALGREEN CO.,

Applicant.

Opposition No. 91184978

**DECLARATION OF LAURA POPP-ROSENBERG
IN SUPPORT OF OPPOSER'S OPPOSITION TO
APPLICANT'S MOTION TO COMPEL PRODUCTION OF DOCUMENTS**

I, Laura Popp-Rosenberg, hereby declare under penalty of perjury:

1. I am an attorney with Fross Zelnick Lehrman & Zissu, P.C., attorneys for opposer McNEIL-PPC, Inc. ("McNEIL") in the above-captioned opposition proceeding. I submit this declaration in support of Opposer's Opposition to Applicant's Motion to Compel Production of Documents. I make this declaration based on personal knowledge of the facts and circumstances set forth herein.

2. On May 5, 2009, Applicant Walgreen Co. ("Applicant") served Applicant's Second Request for Production of Documents and Things (the "Second Document Requests") on McNEIL. (*See* Mot. to Compel at Exh. A.)

3. Applicant's Second Document Requests included a request targeted to the communications between McNEIL or its parent company, Johnson & Johnson ("J&J") and the owner of the ZYRTEC mark, UCB. Specifically, Request No. 32 sought

[a]ll communications between persons employed by UCB
Pharma, S.A., UCB S.A. and McNeil-PPC, Inc. [sic],

McNEIL Consumer Healthcare, Johnson & Johnson, or any of their divisions or related companies in Opposer's possession, custody and control concerning Applicant's use or registration of Applicant's Mark or this Opposition.

(*See* Mot. to Compel at Exh. A.)

4. McNEIL served its responses and objections ("McNEIL's Response") to Applicant's Second Document Requests on July 11, 2009. (*See* Mot. to Compel at Exh. B.) McNEIL's Response incorporated by reference the General Objections set forth in Opposer's Objections and Responses to Applicant's First Request for Production of Documents and Things. (*See id.*) A true and correct copy of those general objections is attached hereto as Exhibit 1.

5. McNEIL objected to Request No. 32 of Applicant's Second Request for Production of Documents based on the General Objections incorporated by reference and certain specific objections set forth in McNEIL's Response to Request No. 32. (*See* Mot. to Compel at Exh. B.) Based on these multiple objections, McNEIL did not produce any responsive documents.

6. Applicant first notified McNEIL of its concerns with McNEIL's refusal to produce documents in response to Request No. 32 by letter dated June 22, 2009. A true and correct copy of Applicant's June 22, 2009 letter is attached hereto as Exhibit 2.

7. After Applicant's June 22 letter, counsel for the parties undertook email correspondence on the subject of Request No. 32 and McNEIL's objections thereto. A true and correct copy of the email correspondence (in reverse chronological order) between the parties' counsel concerning McNEIL's objections to Request No. 32 is attached hereto as Exhibit 3.

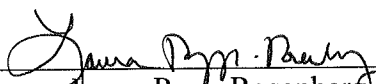
8. As a result of the parties' correspondence on the issue of Request No. 32, McNEIL ultimately agreed to produce a privilege log listing responsive documents. (*See* Mot. to Compel at Exh. C.) In agreeing to produce the privilege log, McNEIL expressly reserved all of its other objections to the request. (*See* Exh. 3; Exh. 4.)

9. Thereafter, counsel for the parties exchanged further email correspondence on the nature of McNEIL's privilege claims. A true and correct copy of this correspondence (in reverse chronological order) is attached hereto as Exhibit 5.

10. Counsel for the parties also held a teleconference on September 2, 2009 to discuss McNEIL's assertion that correspondence between McNEIL or its parent company J&J and UCB was protected from discovery under the attorney-client privilege and/or the work product doctrine. During that teleconference, I explained to Applicant's counsel that the entities at issue shared a common interest in the ZYRTEC mark, and therefore the exchange of confidential and privileged communications between them did not operate as a waiver of either the attorney-client privilege or the work product doctrine under well-established case law. Among other things, Applicant's counsel complained that McNEIL had not identified or produced any written agreement between the entities attesting to the fact that they intended to keep their communications confidential. I advised Applicant's counsel that there was no such written agreement but that the entities did in fact intend their communications to be privileged and confidential.

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 2nd day of November, 2009.



Laura Popp-Rosenberg

EXHIBIT 1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

McNEIL-PPC, INC.,

Opposer,

-against-

WALGREEN CO.,

Applicant.

Opp. No. 91184978

**OPPOSER'S OBJECTIONS AND RESPONSES TO APPLICANT'S
FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rules 26 and 34 of the Federal Rules of Civil Procedure and Rules 2.116 and 2.120 of the Trademark Rules of Practice, Opposer Novartis AG ("Opposer"), by its counsel Fross Zelnick Lehrman & Zissu, P.C., responds as follows to Applicant's First Request for Production of Documents and Things (the "Requests" and each individual request, a "Request") as follows:

GENERAL OBJECTIONS

The following general objections are incorporated in full into each response as if fully set forth therein, and all responses are subject to these general objections.

1. Opposer objects to the requirement that it produce responsive documents within thirty days of service of the Requests as unreasonable. Rule 34 of the Federal Rules of Civil Procedure require only written responses within 30 days of service, and states that production of responsive documents must be at a reasonable time.

2. Opposer objects to the Instructions and Definitions set forth in the Requests to the extent they seek to impose greater burdens on Opposer than are permitted by the Federal Rules of Civil Procedure and the Trademark Rules of Practice.

3. Opposer objects to the definition of “Opposer” to the extent that the definition purports to require Opposer to seek or obtain information that is not in its possession, custody or control.

4. Opposer objects to the definition of “Advertising” as vague and ambiguous. Opposer will interpret “Advertising” as used in the Requests to encompass only those activities considered by Opposer to constitute marketing, promotion and advertising.

5. Opposer objects to every Request to the extent that it calls for documents subject to the attorney-client, work product or other privilege.

6. Opposer objects to every Request that calls for the production of “any,” “each” or “all” documents or information of a specific nature or type, when a limited amount of such documents or information will provide the requested information.

7. Opposer objects to every Request to the extent that it is not limited as to time. Unless specifically noted otherwise, Opposer will generally produce responsive documents relating to the past five years.

8. Opposer objects to every Request to the extent that it is not limited to information concerning activities in the United States. Except as otherwise specifically stated, Opposer will produce responsive documents only concerning activities in the United States.

9. Opposer’s responses and objections are without prejudice to, and Opposer does not waive, any evidentiary objections relating to any Request.

10. Where Opposer has objected on the grounds that a Request is burdensome, duplicative and/or overbroad, it nevertheless may provide responsive information that it considers to be sufficient for the purposes of the proceeding with respect to the subject of the Request. The fact that Opposer has provided such information is not a waiver of its objections.

11. Opposer has not concluded its investigation of the facts relating to this case and has not completed formal discovery or preparation for trial. Accordingly, there may exist documents responsive to the Requests that Opposer does not yet have knowledge of or has not yet located, identified or reviewed. All of the following responses are therefore based on such documents currently known or available to Opposer after a reasonable inquiry. Opposer reserves the right to alter, amend or supplement its responses at any time, including after the close of discovery.

12. Nothing contained in any response to any Request shall be construed as an admission by Opposer relative to the existence or non-existence of any documents or information, and no such response shall be construed as an admission respecting the relevance or admissibility of any document or information, or the truth or accuracy of any statement or characterization contained in any Request.

SPECIFIC OBJECTIONS

The following specific objections may be incorporated in Opposer's response to a particular Request. Opposer's decision not to specifically reference one or more of the following objections in its response to a particular Request is not an admission that the Request is not objectionable on that basis.

A. The Request exposes Opposer to undue burden or expense in relation to its likely benefit, taking into account the needs of the case, the property in controversy, Opposer's

EXHIBIT 2

LAW OFFICES
LEYDIG, VOIT & MAYER, LTD.
A PROFESSIONAL CORPORATION

JAMES B. MUSKAL
DENNIS R. SCHLEMMER
JOHN W. KOZAK
MARK E. PHELPS
H. MICHAEL HARTMANN
BRUCE M. GAGALA
CHARLES H. MOTTIER
JOHN KILYK, JR.
ROBERT F. GREEN
JOHN B. CONKLIN
JAMES D. ZALEWA
MARK J. LISS
JOHN M. BELZ*
BRETT A. HESTERBERG
JEFFREY A. WYAND*
PAUL J. KORNICZKY
PAMELA J. RUSCHAU
STEVEN P. PETERSEN
JOHN M. AUGUSTYN
CHRISTOPHER T. GRIFFITH
WESLEY O. MUELLER
JEREMY M. JAY*
LYNN A. SULLIVAN
JEFFREY B. BURGAN
ELEY O. THOMPSON
MARK JOY
DAVID M. AIRAN
XAVIER PILLAI
GREGORY C. BAYS
STEVEN H. SKLAR
TAMARA A. MILLER
M. DANIEL HEFNER
SALIM A. HASAN
KENNETH P. SPINA
PHILLIP M. PIPPENGER
ANNE E. NAFFZIGER***
CLAUDIA W. STANGLE

JOHN E. ROSENQUIST
ROBERT V. JAMBOR**
JAMES M. ROBERTSON**
FRANCES M. JAGLA***
CHARLES S. COHEN
JOSEPH C. CONTRERA*
THOMAS D. PAULIUS
PAUL J. FILBIN
JOHN L. GASE
ROBERT T. WITTMANN
KEVIN C. PARKS
CAROLINE L. STEVENS
J. KARL GROSS
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STEPHANIE M. LAWLEY*
THOMAS K. MCBRIDE, JR.
MARCOS P. RIVAS
CHRISTINE M. COCHRAN
JOHN P. SNOW
DIMITRY KAPMAR
CARYN C. BORG-BREEN
ANGELA J. BAYLIN
ASHLEE B. MEHL
JOHN K. WINN
ATANU DAS
BORIS UMANSKY
KEVIN C. KEENAN
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TWO PRUDENTIAL PLAZA, SUITE 4900
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(312) 616-5600
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June 22, 2009

URGENT

*Via E-mail
Confirmation Via U.S. Mail*

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(202) 737-6770
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(815) 963-7661
FACSIMILE: (815) 963-7664

SEATTLE OFFICE
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SEATTLE, WASHINGTON 98101-4011
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DEREK W. BARNETT JONATHAN M. SPENNER
KATHLEEN M. HELM-BYCHOWSKI ALAN J. HICKMAN
FRANCIS J. KOSZYK TIMOTHY R. CARLSON
ELIZABETH M. CROMPTON* P. RAYMOND CHEN

ALL RESIDENT IN CHICAGO EXCEPT AS NOTED
*RESIDENT IN WASHINGTON OFFICE ***RESIDENT IN SEATTLE OFFICE
**RESIDENT IN ROCKFORD OFFICE

Laura Popp-Rosenberg
Fross Zelnick Lehrman & Zissu, P.C.
866 UN Plaza
New York, NY 10017

**Re: Trademark Opposition to WAL-ZYR
Our Ref.: 262981**

Dear Laura:

We are writing in regard to outstanding matters related to discovery in the above-referenced matter. As we mentioned in our June 19, 2009 email to you, we have received McNeil's written responses to our Second Set of Document Requests, but we have not received McNeil's documentary responses. We understand from your June 19, 2009 e-mail that these documents are forthcoming.

We need to receive the documents no later than Wednesday, June 24, 2009, so we have time to prepare for Mr. Hooda's personal deposition on Monday, June 29, 2009. If we do not receive the documents by Wednesday, it may be necessary to reschedule Mr. Hooda's personal deposition, which we do not want to do, given that we have already made travel arrangements, given everyone's busy schedule, and given the close of discovery deadline.

Despite your assurances, we are quite concerned that we will not receive the requested documents in a timely manner, given that we still have not received them, and given the objections in McNeil's written responses to our Second Set of Document Requests, which we have now had a chance to review. To avoid any confusion as to what documents we are waiting

for and expect to receive, we prepared this letter, listing such documents, and addressing McNeil's objections to our document requests.

To begin, McNeil objected to many of the requests in our Second Set of Document Requests (as well as in our First Set) as vague, not reasonably particular, duplicative, unduly burdensome, and as calling for documents outside McNeil's custody and control. We do not agree with any of these objections, and we do not think a TTAB Judge would agree either. Frankly, these objections are unreasonably obstructive in our opinion. We do not see how our requests could still be vague, not reasonably particular, or duplicative, given that we have asked for some or all of the documents in our First Set of Document Requests, during Mr. Hooda's first deposition, in writing in follow-up letters (as requested), and a Second Set of Document Requests (as requested).

We also do not see how producing these documents is unduly burdensome. We issued our First Set of Document Requests in October 2008, and asked for additional documents in Mr. Hooda's deposition in March 2009, and we consented to a one-week extension of McNeil's deadline to produce documents in response to our Second Set of Document Requests. Certainly, McNeil has had plenty of time to identify, prepare, and send us responsive documents. Further, the documents that we have requested are customary in opposition proceedings.

The purpose of all of this is to develop the evidentiary record so the parties can litigate this dispute in a fair and fully informed manner. Our document requests are fair and reasonable, and they mirror the language used in requests issued in many TTAB oppositions, and even the language in some of McNeil's own discovery requests. If McNeil intends to maintain these objections and withhold any documents based on these objections, we ask that McNeil provide an explanation, so the matter can be resolved and so we receive the requested documents by Wednesday.

In particular, McNeil should identify anything it claims to be vague, not understood, or not reasonably particular. McNeil should explain how any of the document requests are overly burdensome. To the extent McNeil claims the document requests are duplicative or cumulative, McNeil should produce its documents, in response to one or another of the document requests. Finally, as we have explained before, Walgreens is not asking for any documents that are not in McNeil's custody, possession or control. We have addressed below McNeil's objections to the relevancy of certain requests.

Document Request 32: McNeil's communications with people employed by the companies identified in this request and concerning Walgreens' use or registration of the ZYRTEC mark are certainly relevant to this proceeding. For example, if the owner of the ZYRTEC mark indicated that it does not believe confusion is likely or that it did not want to pursue this opposition, such information and communications are certainly relevant. Thus, we reiterate our request for documents responsive to this request.

Document Request 33: The requested documents are relevant because they pertain to McNeil's standing in this case and McNeil's allegations that it is a licensee of the owner of the ZYRTEC trademark. McNeil still has not produced any documentary evidence showing it has standing to plead the registrations for the ZYRTEC mark in this opposition. We reiterate our request for documents responsive to this request.

Document Request 38: The requested documents are relevant to the perceived meaning of the ZYRTEC mark and any questions concerning an affiliation with WAL-ZYR. We reiterate our request for documents responsive to this request.

Document Request 43: The requested documents are relevant to the extent McNeil intends to rely on expert or other consultant testimony during the course of these proceedings. We reiterate our request for documents responsive to this request.

We also need to revisit outstanding issues concerning McNeil's responses to Walgreens' First Set of Document Requests. We have raised these issues in prior correspondence, but the issues have not been adequately addressed, and we have not received responsive document.

Doc. Request No. 7: This request calls for documents relating to plans for future expansion of the goods or services sold under ZYRTEC. As mentioned in our April 14, 2009 letter, the TTAB has held that an opposer's plans for expansion may be relevant to an opposition. TBMP § 414(8). Thus, we ask McNeil to respond fully to this request.

Doc. Request No. 14: In response to this request, McNeil said it would produce responsive documents, i.e., a list of competitors for the goods offered or intended to be offered under the ZYRTEC mark. McNeil has not produced such a document, and we ask that McNeil do so.

Doc. Request No. 16: McNeil agreed to produce media references to the ZYRTEC mark, such as media schedules identifying publications in which McNeil has advertised the ZYRTEC products. However these documents have not been produced. We ask McNeil to produce responsive documents.

Document Request 19: McNeil agreed to provide us with representative samples of its advertisements for ZYRTEC. While we have received representative samples of press releases, marketing materials relating to marketing of the prescription ZYRTEC, printouts of McNeil's various ZYRTEC-related websites, and plans for FSI pages, we have not received representative samples of print advertisements as they were seen by the general public, television commercials for ZYRTEC as they were seen by the general public, nor storyboards for those commercials. We expect to receive these documents from McNeil.

We understand McNeil objects to the production of storyboards. As pointed out in Mr. Hooda's prior deposition, storyboards contain planning information that would not be reflected in final television commercials. Such planning information is certainly relevant and goes directly to the issue of likelihood of confusion, awareness of the ZYRTEC mark, and McNeil's claims of dilution. We reiterate our request for these documents.

Document Request 20: McNeil objected to providing information regarding payments made to Walgreen Co. for advertising and promotional efforts on the basis that Walgreen Co. would have such information. Whether or not Walgreens may have the information does not obviate McNeil's obligation to produce the information and documents, and it is not germane to the issue of whether or not such information is relevant to the proceedings.

Your May 7, 2009 letter states that if it is "simple" to obtain documents responsive to this request, McNeil will produce them. McNeil's obligation goes beyond producing only those documents that are "simple" to produce. Indeed, in our experience, it is rarely simple to identify and prepare documents for production. Assuming these documents are within McNeil's custody, possession or control, we expect McNeil to produce them.

Finally, we received documents from McNeil reflecting expenditures on advertising through 2008. We ask that McNeil update its production to reflect actual advertising expenditures to date.

Document Request 21: We received documents showing sales of prescription ZYRTEC from 1996-2007 and sales of over-the-counter ZYRTEC from January 2008-March 2009. This request calls for sales figures. Sales figures typically include both dollars in revenues, and number of units sold. To the extent this was not understood, we are clarifying it here, and we ask that McNeil send us documents showing number of units sold, particularly for the sales of over-the-counter ZYRTEC from January 2008 to the present. We also ask that McNeil update its sales figures (provided in dollars) to date.

Document Request 23: In our April 14, 2009 letter, we requested the list of all questions used in surveys regarding brand awareness, advertising awareness, and usage of ZYRTEC and its competitors. McNeil has not commented upon this specific request, nor has it produced relevant documents. Such information is relevant to determining the scope of any such survey and weight to be given to any such surveys. Thus, we reiterate our request for such documents.


Doc. Request No. 27: This request seeks documents relating to any objections by McNeil to any third party marks based in whole or in part on the ZYRTEC mark. McNeil stated it would produce responsive documents, if any exist. We have not received any responsive documents, and we ask that McNeil either produce the responsive documents or confirm that no such documents exist.

Laura Popp-Rosenberg
June 22, 2009
Page 5

Should you wish to further discuss these concerns, please feel free to give me a call. We look forward to hearing from you.

Very truly yours,

LEYDIG, VOIT & MAYER, LTD.

By: 
Caroline L. Stevens

CLS/mlc

cc: Mark J. Liss
Richard Z. Lehv

EXHIBIT 3

Laura Popp-Rosenberg

From: Laura Popp-Rosenberg
Sent: Monday, August 03, 2009 7:59 PM
To: Stevens, Caroline
Cc: Liss, Mark; Richard Lehv
Subject: RE: WAL-ZYR Opposition; LVM Ref. 262981

Dear Caroline:

In an effort to reduce the amount of unnecessary email writing, I will not respond to your various contentions below in detail. However, I will state that your arguments are flatly wrong, most notably but not limited to regarding whether or not McNEIL is permitted to refuse to respond to discovery requests and withhold information on the basis that the request are not reasonably calculated to lead to the discovery of admissible evidence, and regarding the scope of the common interest privilege.

Your arguments below have done nothing to convince us that our objections to the discovery requests at issue are not valid, and we maintain all of them. However, solely in the interest of moving this proceeding along, and without waiving any of our objections, we will agree to provide the information requested through Interrogatory No. 23 and the documents requested by Document Request No. 32. To be crystal clear, we are providing responses to these discovery requests without waiver of and notwithstanding our valid objections which would entitle us to wholly withhold the requested information. Should Walgreens challenge our response to these discovery requests in whole or in part, we will rely on all of our previously stated objections.

We will provide the information requested through Interrogatory No. 23 by tomorrow. I do not know whether we will be able to have McNEIL's certification of the interrogatory response by tomorrow, but will provide it as soon as reasonably possible.

We will also produce any non-privileged documents responsive to Document Request No. 32 tomorrow. We will endeavor to produce a privilege log identifying responsive, privileged documents by the end of this week.

Regards,
Laura

From: Stevens, Caroline [mailto:cstevens@leydig.com]
Sent: Wednesday, July 29, 2009 1:40 PM
To: Laura Popp-Rosenberg
Cc: Liss, Mark; Richard Lehv
Subject: WAL-ZYR Opposition; LVM Ref. 262981

Dear Laura:

McNeil has repeatedly said it is not withholding documents it is required to produce. The problem is, we seem to disagree as to the documents and information that McNeil is required to produce. We discussed Walgreens' requests and McNeil's objections in detail below, but to use plain English, if McNeil has communicated with UCB about the WAL-ZYR mark or this opposition, Walgreens has requested through Interrogatory No. 23 and Doc. Request No. 32 copies of the communications and the names of the UCB individuals with whom McNeil communicated. These documents and information are relevant or could lead to relevant information, they are not privileged, and there is no reasonable justification for withholding them. We think the Board would agree.

McNeil objects to these requests on the grounds that they are not "reasonably calculated to lead to the discovery of admissible evidence." Whether responsive information and documents are *admissible* is an issue that the Board will decide when the parties submit evidence at the time of trial. It is not an issue for McNeil to decide, or a basis for

withholding the production of responsive documents. Indeed, documents and information that are not admissible could still be relevant or could lead to the discovery of relevant information and documents.

The rules of discovery require that McNeil produce responsive information and documents that are relevant or likely to lead to the discovery of relevant information and documents. Obviously, we will not know what the documents say until we are allowed to see them. However, UCB's communications (and communications to UCB) concerning the WAL-ZYR mark or this opposition could refer to the very important topic of likelihood of confusion (or a lack thereof) between the ZYRTEC and WAL-ZYR marks. The communications could refer to factual and empirical data, surveys, expert reports, and other documents regarding confusion between the marks, or any number of other relevant topics, and could include admissions by McNeil. The communications could concern whether McNeil has the right to file the opposition, despite the fact that UCB owns the ZYRTEC trademark registration. As you point out, standing is a factual issue, and facts set forth in UCB's communications could cite facts relevant to this topic. We do not think these issues are "tangential" to the proceeding, or if they are, that they are so tangential that McNeil does not have to produce the documents and information.

We do not agree that these discovery requests impose an undue burden or expense on McNeil, or that the requests are not reasonably particular. We have written the requests so they are narrowly tailored to the subjects of the WAL-ZYR mark and this opposition, and McNeil could identify the requested communications and information by a customary search of its correspondence and electronic messages files for terms such as WAL-ZYR, WALZYR, opposition, and so on. If McNeil believes this request is unduly burdensome or expensive because the responsive documents are so voluminous, we would be interested in learning this, and it may tend to indicate that the requested documents are highly relevant to the proceeding.

McNeil objected to these requests as vague and/or ambiguous due to use of "registration," "employed," and "divisions or related entities." Walgreens used "registration" in the phrase "regarding ... registration of Applicant's Mark ..." to refer to the registration process, not a registered mark. Walgreens used "employed" in the ordinary dictionary sense, i.e., the state or condition of being hired or in the employ of another company, being compensated for work done for the entity. Before we address "divisions or related entities," the named entities are not vague or ambiguous, so at the very least, McNeil should immediately produce documents and information responsive to the requests with regard to those entities. We included "divisions or related entities," because the names of the divisions and related entities that employ individuals who may correspond with regard to the WAL-ZYR mark and this opposition may change due to corporate restructuring or change of responsibilities among different entities and divisions.

We do not agree that the requested information and documents are cumulative or duplicative or that they could be obtained from some other more convenient, less expensive source. If McNeil has the documents and information, McNeil must produce them, and this would be the most convenient and least expensive way for Walgreens to obtain them.

McNeil claims these documents and information are protected by the "common interest" and/or another privilege. The "common interest" privilege does not apply here. The "common interest" privilege enables defendants to exchange *privileged* communications (such as attorney-client communications and work product) to prepare a defense, without waiving the privilege of the documents. Communications between UCB and McNeil are not privileged, and UCB is not a party to this proceeding, so the "common interest" privilege does not apply. When you refer to "another privilege," we do not know what you mean, and we are not aware of any privilege that would shield these documents and information from production. Finally, if there are bona fide privileged documents, they obviously must be identified on McNeil's privilege log.

We have been through much of this discussion before, and we feel we are being put off by groundless objections. The relevance of these documents and information is quite basic, and there is no objection or privilege that excuses McNeil from producing them. McNeil has had ample notice of our requests for the documents and information, and our repeated disagreement with its objections and refusals. If we do not receive documents and information responsive to

the above-referenced requests by Monday, August 3, 2009, we contact the Interlocutory Attorney with regard to a Motion to Compel.

Regards,

Caroline

Caroline L. Stevens
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Two Prudential Plaza, Suite 4900
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Tel: (312) 616-5671
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E-mail: cstevens@leydig.com

Laura Popp-Rosenberg

From: Laura Popp-Rosenberg
Sent: Tuesday, July 28, 2009 12:17 PM
To: Stevens, Caroline
Cc: Liss, Mark; Richard Lehv
Subject: RE: WAL-ZYR Opposition - Discovery Issues; LVM Ref. 262981

Dear Caroline:

As I have previously advised you, and will repeat again, McNEIL is not withholding documents that it is required to produce.

With regard to the June 25, 2006 agreement, I have a request in to my client to explain the discrepancy between the document ID number on the agreement and the document ID number on the signature pages. I will let you know as soon as I have a response.

With regard to the February 10, 2006 agreement between Pfizer and Warner Lambert, that document has already been produced at McNeil 000230-236.

With regard to Interrogatory No. 23 and Request for Production No. 32, we maintain our position that both of these requests are not reasonably calculated to lead to the discovery of admissible evidence. You claim that these requests may lead to admissible evidence on the theory that it may reveal information regarding UCB's "opinion on issues related to this matter" and/or may "have some relevance to the issue of standing." First, we fail to see how UCB's opinion on *any topic* is relevant to anything at issue in the opposition proceeding. Please identify those topics at issue in the proceeding as to which you believe UCB's opinion has relevance, and also how exactly UCB's opinion affects the legal determination of the topics you identify. With regard to standing in particular, standing is a factual and legal issue and not dependent on UCB's opinion.

We also maintain our other objections to the Requests, including that the Requests expose Opposer to undue burden or expense in relation to the likely benefit of the information requested (particularly since there is no benefit to the information requested since it is irrelevant to any of the issues in the proceeding); that the Requests are overbroad as seeking information that is not reasonably particular (e.g., goes beyond what you claim the possible relevance is) and, even if the requested information were somehow relevant, such information is merely tangential to the issues in the case; that the Requests are vague and ambiguous, including by not adequately specifying the alleged relevant "divisions or related entities" of a third party, by referencing a registration that does not exist, and by using the undefined and ambiguous term "employed"; and that the Requests seek communications that are protected from disclosure under the common interest and/or another privilege.

Regards,
Laura

From: Stevens, Caroline [mailto:cstevens@leydig.com]
Sent: Friday, July 24, 2009 11:29 AM
To: Laura Popp-Rosenberg
Cc: Liss, Mark; Richard Lehv
Subject: WAL-ZYR Opposition - Discovery Issues; LVM Ref. 262981

Dear Laura:

While it is correct that Walgreens continues to produce documents during the discovery period, Walgreens does so to *supplement* its prior production, particularly with regard to updated sales figures and advertising samples. Walgreens has diligently searched for and produced relevant requested documents, and we are not

aware of any documents that McNeil requested but that have not been produced. This is far different from failing to produce any documents (which we have repeatedly requested) responsive to certain requests.

We received the documents alleged to be the signature pages for the June 25, 2006 agreement. Obviously, we could not have known that the agreement was signed when McNeil had produced only an unsigned copy. Moreover, the signed signature pages do not match the version of June 25, 2006 agreement that we received. The June 25, 2006 agreement has a document ID number on all of the pages, including on the blank signature page. This number does not appear on the signed signature pages we received from you, and in fact, Mr. Shedlarz signed signature page shows a different number. We request that McNeil produce a complete copy of the June 25, 2006 agreement with signed signature pages.

We do not agree that McNeil is not required to produce unredacted documents, but because McNeil has represented that the redacted portions are not relevant, we will not pursue the issue further. We will, however, object to any attempt to rely on redacted portions of any documents.

The June 25, 2006 agreement refers to a February 10, 2006 agreement between Warner Lambert and Pfizer regarding rights in the ZYRTEC mark. (See Para. 40.) This agreement appears to be responsive to our requests and relevant to this proceeding, and we request that McNeil produce a copy as soon as possible.

Finally, we reiterate our request that McNeil produce documents responsive to Document Request No. 32 and that it provide a written response to Interrogatory No. 23 by **July 27, 2009** so we can avoid filing a Motion to Compel.

Regards,

Caroline

Caroline L. Stevens - (312) 616-5731 - cstevens@leydig.com

From: Laura Popp-Rosenberg [<mailto:lpopp-rosenberg@frosszelnick.com>]
Sent: Wednesday, July 22, 2009 6:12 PM
To: Stevens, Caroline
Cc: Richard Lehv
Subject: RE: WAL-ZYR Opposition - Discovery Issues; LVM Ref. 262981

Dear Caroline:

We maintain our position that McNEIL has the right to continue to produce documents throughout the discovery period. This is not gamesmanship. I have asked McNEIL to collect all documents they are required to produce in this proceeding, and I am not withholding any documents that have been given to me by my client. I note that Walgreens seems also to be availing itself of its right to produce documents on a continuing basis, having just produced a large number of documents this week.

We disagree with your assertion that we have not produced the documents that show McNEIL's standing in this proceeding or its license to use the ZYRTEC mark. Should you continue to believe that the materials we have produced do not show McNEIL's standing in the opposition, that would seem to me to be a legal question for the trial phase of this proceeding.

The June 25, 2006 agreement was signed. We had not realized until your email that the version produced was unsigned. Please see attached signature pages, which should be added to McNEIL's production in this matter.

The redactions of the June 25, 2006 agreement are of information that has no relevance to this proceeding. Therefore, we are not required to produce an unredacted version of the agreement, regardless of the confidentiality agreement, and will not do so.

We are still conferring with our client with regard to Interrogatory No. 23 and Document Request No. 32, and will try to have a definitive answer to you next week as to whether we will be revising our responses to these requests.

Regards,
Laura

Laura Popp-Rosenberg

From: Stevens, Caroline [cstevens@leydig.com]
Sent: Tuesday, July 21, 2009 11:35 AM
To: Laura Popp-Rosenberg
Cc: Liss, Mark; Richard Lehv
Subject: WAL-ZYR Opposition - Discovery Issues; LVM Ref. 262981

Dear Laura,

We are writing in an effort to try to amicably resolve our concerns over McNeil responses to certain of Walgreens' document requests. We reiterate our request that McNeil produce documents requested in Document Request No. 32, which we still have not received. We understand from conversations with you that McNeil's position is that it can produce documents at any time during the discovery period, including up and until the last day of discovery. This position overlooks McNeil's obligation to produce documents in a *timely manner*. This position amounts to unprofessional gamesmanship, and not what litigation should be about. We believe the Board would agree.

We also reiterate our request that McNeil substantively respond to Interrogatory No. 23. McNeil responded by only listing objections on the grounds of undue burden or expense; that the Interrogatory was not reasonably calculated to lead to the discovery of admissible evidence; that the Interrogatory was not reasonably particular or that it sought information tangential to the matters at issue; and that the wording of the Interrogatory is vague and/or ambiguous. We disagree with all of these objections.

As we have explained in the past, information responsive to this Interrogatory is relevant and admissible, because it could pertain to or lead to information about the owner of the ZYRTEC trademark's opinion on issues related to this matter, and the interrogatory may also have some relevance to the issue of standing. Given the relevance of this evidence, we do not agree that requiring production is an undue burden or expense. We also do not agree that any portion of the Interrogatory is vague or ambiguous. If McNeil intends to maintain this objection, McNeil should identify the words that are too ambiguous and/or vague for McNeil to properly respond.

We also have not received documents that demonstrate McNeil has standing in this case or is licensed to use the ZYRTEC mark, as requested in Document Request No. 22 and 33. The agreement dated June 25, 2006 is not signed, it is heavily redacted, and it includes no schedules. Frankly, it is worthless to us. As a result, so is the agreement dated December 20, 2006. Given the protective order, we are entitled to unredacted copies of all of the agreement, and we request that McNeil produce them. Please also let us know whether the June 25, 2006 agreement was ever signed, and if so, please produce a copy. Finally, please confirm that there are no other documents responsive to these requests.

If we do not receive these documents by **July 28, 2009**, we will be forced to request the intervention of the TTAB Interlocutory Attorney or to file a Motion to Compel. Filing a Motion would cause the suspension of the opposition, and both the Motion and contacting the Interlocutory Attorney would cause undue hassle to all parties involved. We would like to avoid all of this. Please contact us to discuss this matter further.

Regards,

Caroline

Caroline L. Stevens
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E-mail: cstevens@leydig.com

Laura Popp-Rosenberg

From: Laura Popp-Rosenberg
Sent: Tuesday, June 23, 2009 12:22 PM
To: Stevens, Caroline
Cc: Richard Lehv
Subject: McNEIL v. Walgreens

Dear Caroline:

I received your letter dated June 22, 2009. As a general matter, I object to the tone of your letter and your attempt to impose deadlines on my client that are beyond those set in the Federal Rules of Civil Procedure and the Trademark Rules of Practice. There is no rule requiring my client to produce documents on a date certain. Your firm's decision to schedule Mr. Hooda's second deposition so shortly after serving document requests does not mean that my client is obligated to make its production for your convenience. I expressly disagree with your statement that Walgreens consented to a one-week extension of McNEIL's deadline to produce documents: Walgreens consented to a one-week extension of McNEIL's deadline to provide written discovery responses. It could not have consented to extend a deadline that did not exist.

As I told you last week, we expect to make a further document production this week, and will make it as early as possible in light of the deposition schedule. However, my client will continue to reserve its right to produce additional documents throughout the discovery period.

I am available to discuss specific issues raised in your letter by telephone tomorrow. My schedule is fairly flexible, but I will suggest 11 AM. If that time does not work for you, please suggest an alternative.

Regards,
Laura

Laura Popp-Rosenberg | [Fross Zelnick Lehrman & Zissu, P.C.](#)
866 United Nations Plaza | New York, New York 10017
T: (212) 813-5943 | F: (212) 813-5901 | www.frosszelnick.com

EXHIBIT 4

Laura Popp-Rosenberg

From: Laura Popp-Rosenberg
Sent: Friday, August 07, 2009 5:43 PM
To: Stevens, Caroline
Cc: Richard Lehv
Subject: McNEIL v. Walgreens
Attachments: F0497524.PDF

Dear Caroline:

Attached please find McNEIL's privilege log. Note that this includes all documents responsive to Document Request No. 32, which we are providing without waiver of our objections to that request.

Regards,
Laura

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T: (212) 813-5943 | F: (212) 813-5901 | www.frosszelnick.com

EXHIBIT 5

Laura Popp-Rosenberg

From: Laura Popp-Rosenberg
Sent: Wednesday, August 26, 2009 12:08 PM
To: 'Stevens, Caroline'
Cc: Liss, Mark; Richard Lehv
Subject: RE: WAL-ZYR Opposition; LVM Ref. 262981

Dear Caroline:

For your information, Ms. Epstein has written a treatise on the issue of attorney-client privilege and work product doctrine, not an "article." I'm surprised you are not familiar with it. However, we would not rely on Ms. Epstein's commentary (although we could), but rather on the multitudes of cases she cites.

I'm not sure how you can say that you do not have any "authority, documentation, or allegations that support McNeil's position" in one sentence, and then in the next say that all the cases you have seen are distinguishable. On what point are they distinguishable if you profess not to understand McNeil's position? In any event, I also request that you not send us cases that are not on point.

Regards,
Laura

From: Stevens, Caroline [mailto:cstevens@leydig.com]
Sent: Wednesday, August 26, 2009 12:01 PM
To: Laura Popp-Rosenberg
Cc: Liss, Mark; Richard Lehv
Subject: WAL-ZYR Opposition; LVM Ref. 262981

Dear Laura:

We do not consider an article by Ms. Epstein to be authority on the matter, but we will try to locate the article and review it for the purposes of our call. It is McNeil's burden to show that the requested communications were privileged and that any such privilege was retained even though the communications were disclosed to third parties. We have yet to see any authority, documentation, or allegations that support McNeil's position, so at this stage, we cannot provide authority to refute a point that McNeil has not made, other than through mere allegations. While we have reviewed numerous cases that address the issue of the common interest doctrine, none of them supports McNeil's position, as they are all distinguishable from the case at hand. We do not intend to send you a bunch of cases that are not on point.

We will call you on September 2 at 3 PM EDT / 2 PM CDT.

Regards,

Caroline

Caroline L. Stevens - (312) 616-5731 - cstevens@leydig.com

From: Laura Popp-Rosenberg [mailto:lpopp-rosenberg@frosszelnick.com]
Sent: Wednesday, August 26, 2009 10:33 AM
To: Stevens, Caroline
Cc: Liss, Mark; Richard Lehv
Subject: RE: WAL-ZYR Opposition; LVM Ref. 262981

Dear Caroline:

I am available at 3 PM EDT / 2 PM CDT on September 2, and will anticipate your call.

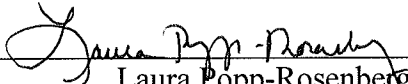
In response to your request for authority, I invite you to read *The Attorney-Client Privilege and the Work Product Doctrine* (5th ed.) by Edna Selan Epstein, in particular pages 274 and following. I believe there is plenty of authority in that section to support our position. Of course, if Walgreens files a motion to compel, we reserve the right to cite any authority, whether referenced in Ms. Epstein's treatise or not.

We ask that you return the favor, and provide us with any authority relevant to the issue and supportive of Walgreens' position.

Regards,
Laura

CERTIFICATE OF SERVICE

This is to certify that I caused a true and correct copy of the foregoing Declaration of Laura Popp-Rosenberg in Support of Opposer's Opposition to Applicant's Motion to Compel Production of Documents to be served via First Class Mail in an envelope addressed to counsel for Applicant, Mark J. Liss, Esq., Leydig, Voit & Mayer, Ltd, Two Prudential Plaza, Suite 4900, Chicago, Illinois 60601-6731, this 2nd day of November, 2009.



Laura Popp-Rosenberg